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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/344,010	06/25/1999	STEVEN JEROME MOORE	122995-43-34	8566

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10/04/2002

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EXAMINER

TAYLOR, LARRY D

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 10/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/344,010

Applicant(s)

MOORE, STEVEN JEROME

Examiner

Larry D Taylor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt of Amendment

1. Receipt is acknowledged of the amendment filed 2 July 2002.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 7 recites the limitation "the lot" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined

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was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claim 22-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Scroogie et al. (US 5,970,469, of record).

Scroogie teaches a computer-assisted method of purchase, whereas a purchaser uses an identity card to purchase a good. The card would contain information, possibly pointing to an email address of the customer. When an identifier on the good is scanned by a scanner (col. 11, lines 60-62), the good is correlated with the customer in a database. Secondary purveyors, such as retailers or supermarkets are able to access the characteristics of the goods and offer discounts, coupons, or services based on the goods purchased by the customer. Such offers would provide an address as to where to used these discounts or services. These purchases and offers would be available via Internet. (See figures 13-15, col. 3, lines 14-38, col. 4, lines 34-40, col. 12, lines 8-42, and col.12, line 64 – col. 13, line 9).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 26-27 are rejected under 35 U.S.C. 102(b) as being anticipate by Fahner et al. (US 4,822, 973, of record).

Fahner teaches a method for encoding concealed identifiers on an item, the method

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includes directing electromagnetic laser beams from laser 10 to a molten plastic material 14 on a part, the beams forming a unique identifier (see figures 3 and 4 and col. 4, lines 24-29)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 8-11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roach et al. (US 5,434,394, of record) in view of Collier (US 5,646,365, of record).

Roach teaches a computer assisted method of recording the identity of a purchaser at a retail setting. A customer selects a good to purchase and scans a bar code 68 on the good with scanner 18 or at POS terminal 16, the bar code known to identify the type of good, as well as its manufacturer. An operator at the terminal 16 accepts from the customer an optically encoded identity card 66. A card reader in the terminal reads the card in tandem with the bar code on the good, the information being correlated into a database to be shared by a computer headquarters or other retail systems (see figure 1 and col. 6, lines 28+). A sales receipt can be printed out by the terminal to reflect the purchase. In addition, the customer may also wish for the good to be delivered to his/her address. A telecommunications network ring 34 provides a means of digitally sending information relating to the good, purchaser, and delivery instructions to and from a headquarters network 8 or to a warehouse 40 (see figures 1 and 2, col. 3, line 27 – col. 4, line 6, col. 5, lines 8-17).

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However, it is not specified that the good is enclosed within a package, the package having a bar code, which is correlatable with the good's bar code and is instead scanned at the time of purchase.

Collier teaches the purchasing of gun bullets, the bullets having a bar-coded good identifier therein under an outer surface of the bullet. The good identifier reflects the type of bullet, the lot, and manufacturer of the bullet. At the time of purchase, a customer would provide proper identification, to be cataloged with a bar code read from the package containing the bullets. These information would be held within a national computer database. The bar code on the package would correlate with the bar code in the bullet (see figures 1 and 2, and col. 3, lines 45-64). Collier reiterates that it is well known in the art of retail to scan both a good and the good's package in tandem with the identity of a purchaser. Such an act provides efficient inventory tracking as to what items are present within a package, and in the realm of gun/ammunition purchasing, allows secure and monitored purchasing of regulated items. Thus, it would have been obvious to one of ordinary skill in the art to provide such good/package identification.

11. Claims 12 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roach et al. as modified by Collier, further in view of Moore (US 5,592,561). The teachings of Roach as modified by Collier have been discussed above.

However, it is not taught that the good identifier is invisible to visible light. Such a step in manufacturing is well known in the art, as Moore teaches the authentication of a good, wherein a code, possibly a bar code (col. 15, lines 37-38), is affixed to the good, the code not observable under visible light and can be readable under non-visible light (col. 3, lines 33-49). It

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would have been obvious to one of ordinary skill to employ this well-known tactic, as it prevents an unauthorized person from readily viewing pertinent data regarding an item, which could lead to improper tampering or duplication of that data.

Regarding claim 17, the teachings also do not specify that the position of the identifier on the good is associated with a lot in which the good was manufactured. The teachings of Collier above have stated that the identifier (code) on the good can contain information on the product, such as the type of product, lot, and manufacturer. It would have been an obvious expedient to have the position of the code as a further indication of the lot the good was presented from. With mass production, goods are known to be labeled at an assembly line area in an automated, machine-driven fashion. During such, like goods placed at once in the area could have coded labels placed in a particular position, that position changing when a new lot of goods are introduced for labeling. Such a process is also known to be done with the purpose of tracking quantities of the lots of the goods. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the coded identifier positioned on the good so as to denote a particular lot in which the good was manufactured.

12. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roach et al. as modified by Collier, further in view of Lane (US 5,623,552, of record). The teachings of Roach as modified by Collier have been discussed above.

However, it is not taught that the card is smart card, with the ability to be self-authenticating.

Lane teaches a smart card, that can be used at a plurality of locations, the card containing a microprocessor and means for self authentication and identification of a card holder (see figures 1 and 2, col. 1, lines 16-28).

This card is primarily used for the identification of a cardholder at the time of purchasing a good or service. It would have been obvious to one of ordinary skill in the art to provide such a card, as the smart card processor allows more data to be stored within the memory of the card and the authentication means allows the cardholder to verify identity without extensive assistance from a retail terminal and/or the terminal's operator. When purchasing goods at a retail terminal, as customer would enjoy the ability to identify his or herself in an expeditious manner, as the self-authenticating card would provide.

Response to Arguments

13. Applicant's arguments regarding rejection in view of the teachings of Scroogie (amendment page 9) have been fully considered but they are not persuasive. In specific, the databases (such as history database 502 and consumer database 506) are maintained regarding purchasing histories and tendencies of customers accessing the purchasing system. Patterns of the consumers' purchases are also maintained, such as patterns identifying the types of goods purchased. Guided from this information, secondary purveyors can then send offers at the point-of-retail or by email to the consumer.

14. Applicant's arguments regarding rejection in view of Fahner (amendment pages 9-10) have been fully considered but they are not persuasive. In specific, the teachings of Fahner do in fact teach the use of a laser directing high energy waves at 3-D structure, the material within the

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structure altered such that the material can be unique from another. Column 1, lines 7-13 of Fahner basically summarizes in saying that a laser is used to altering a plastics part beneath its surface.

15. Applicant's arguments regarding rejection in view of Collier (amendment pages 11-12) have been fully considered but they are not persuasive. In specific, the code within the good (bullet) does contain information regarding the purchaser of the bullet. It is well known that this information is held in a central database that can be accessed in national venue, as the bullet can be shipped anywhere. It also would be within the realm of the information to contain a manufacturer's data, and it would have been obvious to have such. The code is synonymous with a serial code, the code known to be redundant or correlated with the manufacturer and/or purchaser. Such serial codes are presently featured on various items, such as electronic devices. Also, while the art does not specifically teach the code as being in bar code, it would have been notoriously obvious for the code to take that form, as it is known in the art that bar codes are favored over alphanumeric characters in terms of entering data into a computer or other device. The scanning of the bar code allows faster and more accurate input means.

16. Applicant's arguments regarding rejection in view of Roach (amendment pages 13-14) have been fully considered but they are not persuasive. In specific, the Examiner holds that, per the teachings of Roach, the scanned code of the product to be purchased may be of the specific good or package of good selected. There are various retail stores, such as electronic specialty stores, in which a package of the good is scanned, the customer to travel to another side of the store to retrieve that particular good. This is common with the purchase of video games, CD players, and other electronic devices that most retailers don't exactly have on the shelves. If the

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customer wishes to have a particular good with a particular feature, the scanned code would reflect such during purchasing. In addition, the teachings of Roach discuss at the checkout terminals 16, a member number may be scanned from a card 66 during purchasing. Both the member data and purchased item are associated together in a transaction record (list) to be viewed by the on-site shippers or for later scrutiny. While the code scanned in Roach may be interpreted as being on the good or package, the combination of the teachings with Collier provide enough motivation to rejection the limitation should the code of Roach be denoted as on the good.

17. Applicant's arguments regarding rejection in view of Lane (amendment pages 15-16) have been fully considered but they are not persuasive. The Examiner contends that the art of Lane provide adequate teachings of a self-authenticating microcircuit card for accurate identification of the purchasing customer.

18. Applicant's arguments with respect to claims 12 and 15-20 have been considered but are moot in view of the new ground(s) of rejection. The Examiner presents the art of Moore, in which the teachings are similar to that of Berson, however, the filing date of the patent of Moore is earlier than the priority date of the present application. The Examiner wishes to note that in the background teachings of Moore, there are various patents listed that discuss the use of encoded labels detectable only under invisible light.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry D Taylor whose telephone number is (703) 306-5867. The examiner can normally be reached on M-F (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (703)-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-746-4784 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Larry D Taylor
September 30, 2002



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